No. 08-1197

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

SMACK APPAREL COMPANY AND WAYNE CURTISS,
Petitioners,

v.

BOARD OF SUPERVISORS OF THE LOUISIANA STATE UNIVERSITY AND AGRICULTURAL AND MECHANICAL COLLEGE, BOARD OF REGENTS OF THE UNIVERSITY OF OKLAHOMA, THE OHIO STATE UNIVERSITY, UNIVERSITY OF SOUTHERN CALIFORNIA, AND THE COLLEGIATE LICENSING COMPANY,
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. Whether two-color combinations, used for decades to identify famous Universities, are protectible trademarks, when this Court already has held in *Qualitex Co. v. Jacobson Products, Co.*, 514 U.S. 159 (1995), that a color alone can be a protectible trademark.

2. Whether the Fifth Circuit Court of Appeals misapplied its own precedent with respect to the "likelihood of confusion" trademark-infringement analysis.

3. Whether the doctrine of "aesthetic functionality," which has been consistently rejected by the courts of appeals, can be used to justify the intentional use of the Universities' color trademarks to market t-shirts to the Universities' fans for the sole purpose of trading on the goodwill associated with those trademarks.

4. Whether the district court in this case properly followed Fifth Circuit precedent in applying the doctrine of nominative fair use.

PARTIES TO THE PROCEEDING AND RULE 29.6 STATEMENT

The parties to this proceeding are Smack Apparel Company and Wayne Curtiss, and the Board of Supervisors of the Louisiana State University and Agricultural and Mechanical College, Board of Regents of the University of Oklahoma, The Ohio State University, University of Southern California, and the Collegiate Licensing Company. Pursuant to this Court's Rule 29.6, Respondent The Collegiate Licensing Company states that more than ten percent of its shares are owned by IMG Worldwide, Inc.

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INTRODUCTION

Out of narrow case-specific holdings, petitioners strain to create sweeping doctrinal issues. The holdings in this case neither raise substantial questions of unsettled federal law nor conflict with any precedent of other courts of appeals or of this Court. The petition itself, largely devoted to the facts and procedural disposition of this case, highlights the limited, case-specific nature of the conclusions below. Two of petitioners' proposed questions aver disagreements by different panels of the Fifth Circuit, an inappropriate basis for seeking a writ of *certiorari*. And the petition's asserted conflicts among authorities stem not from actual disagreements among courts of appeals but from petitioners' omissions of cases demonstrating consistency across the federal courts. For example, the divergence claimed by petitioners between the Fifth and Ninth Circuits on the issue of aesthetic functionality has been eliminated – to the extent that it ever existed at all – by the more recent decisions in *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252 (9th Cir. 2001) and *Au-tomotive Gold, Inc. v. Volkswagen of America, Inc.*, 457 F.3d 1062 (9th Cir. 2006), *cert. denied*, 549 U.S. 1282 (2007), which petitioners fail even to mention.

The exaggerated significance petitioners assign to this case, which is about six t-shirts, derives from petitioners' misapprehension of fundamental trademark principles, not from any actual magnitude of the issues raised. For instance, at least since Judge Learned Hand articulated the principle that "[if] another uses [an owner's trademark], he borrows the owner's reputation, whose quality no longer lies within his own control,"

Yale Electric Corporation v. Robertson, 26 F.2d 972, 974 (2d Cir. 1928), trademark law has been settled with respect to a trademark owner's right to control the quality and reputation of his mark. This case is hardly the first addressing the scope of a trademark owner's rights or an owner's ability to control the reputation and quality associated with its mark. Pet. at 26-30. Indeed, the absence of a substantial legal question in this case may be best demonstrated by the petition itself, which devotes nearly twenty-six of its thirty-eight pages to the specific facts and decisions below, and which frames the "significance" of the issues in terms of a single industry – game-day sports apparel. *Id.* at 30-31.

The Fifth Circuit's decision in this case is closely constrained to the facts and firmly rooted in longstanding principles of trademark law. Accordingly, this Court should deny the petition for a writ of *certiorari*.

STATEMENT OF THE CASE

This case involves the intentional misappropriation and use by a t-shirt vendor, Smack Apparel Company, of the well known trademarks of four Universities – LSU, Oklahoma, Ohio State, and USC. In the weeks leading up to the college football Bowl Championship Series in early 2004, without the respondents' permission, petitioners incorporated the Universities' famous trademarks (including their well-known color schemes in combination with other University-identifying indicia) in designs printed on unlicensed t-shirts that petitioners then sold in the same stores and at the same prices as licensed University t-shirts.

The Universities' football programs are among the most reputable in the country, and their color schemes (*e.g.*, the Purple and Gold of LSU), which have been used and extensively promoted for over a century, are widely recognized as identifying the Universities. *See Bd. of Supervisors v. Smack Apparel Co.*, 438 F. Supp. 2d 653, 658 (E.D. La. 2006); Pet. App. B at 50a. Indeed, respondents' color schemes have become such well-known identifiers that third parties (such as newspapers and magazines) often use them as short-hand references for the Universities (*e.g.*, "Scarlet and Gray" for OSU, "Crimson and Cream" for OU, and "Cardinal and Gold" for USC).[1]

In addition to these color schemes, respondents hold both registered and unregistered trademark rights in their names and commonly used initials. For example,

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[1] Petitioners admit that the Universities' color schemes hold "secondary meaning" and operate as strong trademarks by "conced[ing] that the Universities' color schemes are well-known and are used to identify the plaintiff Universities." *Bd. of Supervisors v. Smack Apparel Co.*, 550 F.3d 465, 479 (5th Cir. 2008); Pet. App. A at 19a. Contrary to the petition's suggestion that third-party uses of respondents' color schemes have weakened the Universities' color schemes' source-identifying qualities, the record "evidence falls far below that of extensive use, and the specific photographs of third-party use here fail to create an issue of fact concerning the public's association between the [Universities] and color schemes and other indicia that clearly reference the Universities." *Id.* (comparing petitioners' meager 31 purported instances of third-party use to cases involving several thousand instances of third-party use, which were considered "extensive" enough to weaken the mark at issue (citing *Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan Ass'n*, 651 F.2d 311, 316 (5th Cir. 1981)).

the University of Oklahoma owns federal trademark registrations for its well-known OU trademark.[2] And respondents routinely grant licenses to third parties to manufacture and sell retail goods, including t-shirts, bearing the Universities' color schemes and other trademarks.

With full knowledge of respondents' color schemes, trademark rights, and licensing programs – but without obtaining a license from any of the respondents – petitioners manufactured and sold the six t-shirt designs at issue in this case.[3] Images of these designs appear in

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[2] Although the University of Oklahoma's registrations for the OU mark issued after petitioners first began selling the "Show us Your Beads!" t-shirt, several facts undermine petitioners' claimed innocence regarding using this mark (Pet. at 8-9), including: petitioners knew that Oklahoma held registrations for the interlocking OU mark; petitioners knew that Oklahoma had common law rights in the plain OU mark; and petitioners did not stop selling the infringing t-shirts after Oklahoma filed trademark applications for the OU mark. *See* 438 F. Supp. 2d at 663; Pet. App. B at 68-69a.

[3] Petitioners devote seven pages of their petition to describing the six t-shirt designs at issue. Pet. at 5-11. Respondents object to these descriptions insofar as they contain legal conclusions and misstatements of fact. In particular, petitioners' descriptions improperly contain legal conclusions, such as "Smack uses words and images which are not trademarks" (Pet. at 3) and "[t]he 'Got Seven?' and 'Got Eight?' t-shirt designs are a parody. . . ." (*id.* at 10). Petitioners' descriptions further contain factual misstatements. For example, contrary to petitioners' claim that "Smack has manufactured virtually identical t-shirt designs for dozens of other schools, including OU and LSU, without objection" (*id.* at

(Cont'd)

the Appendix to this Brief. Resp't App. A. Each of these designs incorporates one of the Universities' color schemes *combined with* other source-identifying indicia, including: (a) well known athletic events in which the subject University has participated; (b) one of the targeted University's opponents in such an athletic event; (c) specific geographic references to where the University is located or the event occurred; (d) athletic titles or honors bestowed on the University as a result of the event; or (e) a University's prior athletic successes or accomplishments (collectively, "identifying indicia").[4]

Consistent with similar cases decided by the courts of appeals and this Court, the courts below held that petitioners intentionally designed t-shirts bearing the Universities' color schemes, in combination with other identifying indicia, and specifically marketed them to the Universities' fans for the sole purpose of trading on

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10-11), respondents have objected often and vociferously to petitioners' conduct. In fact, shortly after the district court entered judgment in this case, respondents successfully brought a contempt action against petitioners for manufacturing and selling t-shirt designs "virtually identical" to those at issue here. *See Bd. of Supervisors v. Smack Apparel Co.*, 574 F. Supp. 2d 601, 603-606 (E.D. La. 2008).

[4] Respondents have not claimed that *any* shirt bearing the Universities' color schemes would be infringing. Rather, respondents consistently have contended that petitioners' sales of the six designs at issue constitute trademark infringement and unfair competition because the color schemes are used *in combination with* other source-identifying indicia. *See* 550 F.3d at 475; Pet. App. A at 11-12a.

the goodwill associated with respondents' trademarks. Petitioners conceded repeatedly, in testimony and throughout briefing, that they "selected the color schemes, logos, and designs for their shirts in order to refer to the universities and *call them to the mind* of the consumer." 438 F. Supp. 2d at 658, Pet. App. B at 57a (emphasis added); *see also* 550 F.3d at 477, Pet. App. A at 15a. Petitioners also conceded that they marketed these t-shirts alongside licensed t-shirts, at the same price point, without any markings indicating the shirts were unlicensed, knowing that consumers might be confused and purchase petitioners' unlicensed t-shirts instead of licensed ones.[5] 550 F.3d at 482; Pet. App. A at 26a.

In seeking a writ of *certiorari*, and attempting to soften previously made concessions, petitioners offer several misstatements. For example, the petition states that petitioners' t-shirts are distinguishable because "Smack is known for [its] humorous messages . . . which are rarely found on licensed products." Pet. at 3. To the contrary, "[i]t is clear from the record . . . that use of creative language is not unique to Smack and does not make Smack's shirts dissimilar to the Universities' own products." 550 F.3d at 480; Pet. App. A at 23a. Nor is it significant, as Smack suggests, that respondents do not license shirts glorifying alcohol consumption, nudity, and sexual promiscuity. Pet. at 18. *See Dallas Cowboys*

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[5] Respondents disagree with petitioners' misleading statements that "Smack does nothing to suggest that its t-shirts are licensed or approved by the schools" (Pet. at 4) and "Smack . . . did nothing to suggest that its t-shirts were endorsed or approved by the schools" (Pet. at 5).

Cheerleaders Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 204 (2d Cir. 1979) (rejecting argument that "no reasonable person would believe that [depraved] film originated with plaintiff" because "to be confused, a consumer need not believe that the owner of the mark actually produced the item and placed it on the market"). In fact, petitioners' "use of irreverent phrases or slang comments misuses [respondents'] reputation and good will, which is embodied in their trademarks." 438 F. Supp. 2d at 660; Pet. App. B at 62a (citing *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1215 (8th Cir. 1976) ("[T]hose who invest time, money and energy in the development of good will and a favorable reputation [should] be allowed to reap the advantages of their investment.")). Nor is it the case that petitioner's two-and-one-half inch logo distinguishes petitioners' shirts or cures consumer confusion. Pet. at 3-4. In fact, there is no "evidence that [petitioners'] logo is recognizable by consumers" and, because respondents "require all licensed products to contain the licensee's name, ... a consumer could believe that Smack's logo merely indicated that it was a licensee." 550 F.3d at 482-83; Pet. App. A at 27-28a. Finally, it is not true that "[t]here was no evidence of actual confusion." Pet. at 14. Rather, the record contains actual-confusion evidence. Petitioners conceded that consumers specifically asked whether petitioners' shirts were licensed. 550 F.3d at 483 n.69; Pet. App. A at 29a n.69. Consumer surveys concerning two of the t-shirt designs showed significant likelihood of confusion. *Id.* And at the trial on damages, the jury found actual confusion. More fundamentally, actual confusion is unnecessary to demonstrate infringement, which hinges on a *likelihood* of confusion. *Id.* at 483, 28a; *see also Brookfield*

Commc'ns., Inc. v. West Coast, Entm't Corp., 174 F.3d 1036, 1050 (9th Cir. 1999); 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:12 (4th ed. 2009) (hereinafter MCCARTHY) (collecting cases).

A. District Court Ruling

Respondents brought this action in June 2004, in the United States District Court for the Eastern District of Louisiana, alleging, *inter alia*, that the sale of these t-shirts by petitioners constitutes trademark infringement and dilution, unfair competition, and deceptive trade practices arising under the Lanham Act, 15 U.S.C. § 1051 *et seq.*; the Louisiana Unfair Trade Practices and Consumer Protection Law, LA. REV. STAT. ANN. 51:1401 *et seq.*; the Louisiana Trademark Law, LA. REV. STAT. ANN. 51:211 *et seq.*; the deceptive trade practices statutes and trademark and antidilution laws of the several states; and the common law. 438 F. Supp. 2d at 656; Pet. App. B at 52a.[6]

On cross-motions for summary judgment on liability, and following summary-judgment hearings, the district court granted summary judgment on liability in respondents' favor. The district court's summary judgment held: (1) the Universities' color schemes not

[6] The Louisiana Unfair Trade Practices Act and the common law of the various states in which petitioners sell their t-shirts provide "independent and adequate state law grounds," which make imprudent a writ of *certiorari*. *See generally* EUGENE GRESSMAN ET AL., SUPREME COURT PRACTICE: FOR PRACTICE IN THE SUPREME COURT OF THE UNITED STATES 207-14 (9th ed. 2007).

only had "secondary meaning" and were protectible, but were "extremely strong marks"; (2) petitioner infringed these marks and committed unfair competition by creating a "likelihood of confusion" among consumers; and (3) petitioner's proffered defenses of functionality, nominative fair use, and laches failed as a matter of law. 438 F. Supp. 2d at 656-63; Pet. App. B at 53-68a.

The summary judgment applied trademark principles well settled by this Court and the courts of appeals. In particular, the district court took great care to apply this Court's holdings that: "a color scheme may be protectible as a trademark if it 'identifies and distinguishes a particular brand (and thus indicates its 'source'),'" *id.* at 657, 54a (quoting *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 163-64 (1995)); and, to receive trademark protection, a color scheme must attain "secondary meaning" – *i.e.*, "'in the minds of the public, the primary significance of [the mark] is to identify the source of the product and not the product itself.'" *id.* (quoting *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211-12 (2000)). It also carefully tracked the Fifth Circuit's "digits of confusion" – noting their congruence with other courts of appeals' "likelihood of confusion factors" – and thoroughly considered and applied precedent from this Court and the courts of appeals concerning functionality, nominative fair use, and laches.

A two-day jury trial on damages followed. After the district court denied petitioners' motion for a judgment as a matter of law, the jury found: (1) petitioners' infringement caused actual confusion of the public; (2) respondents were entitled to actual damages

(a reasonable royalty) in the amount of $7,226.80; and (3) respondents were entitled to an award of petitioners' profits in the amount of $35,686.00.

After hearing motions on injunctive relief, enhancement of damages, and attorneys' fees, the district court permanently enjoined petitioners from "manufacturing, distributing, advertising, selling, or offering for sale any of the six designs found to be infringing in the court's July 18, 2006 summary judgment order or any other designs that are similar to the six infringing designs." The district court declined to award enhanced damages.

Judgment was entered on February 9, 2007, and amended on April 16, 2007, to award prejudgment interest to respondents in the amounts of $508.24 (LSU), $227.10 (OU), $412.41 (OSU), and $39.56 (USC). The district court taxed costs of $16,927.49 against petitioners on April 24, 2007. Attorneys' fees of $94,311.81 were awarded to respondent LSU under the Louisiana Unfair Trade Practices and Consumer Protection Law.

B. Court of Appeals Ruling

The Fifth Circuit unanimously affirmed the district court and denied petitioners' request for rehearing *en banc*. In a thorough opinion, Judge Reavley, writing for the Fifth Circuit, preempted each of petitioners' reasons for seeking a writ of *certiorari*.

Like the district court, the court of appeals meticulously followed this Court's precedent, reasoning,

inter alia, that "[b]ecause the [Supreme] Court recognizes that trademarks may include color, we see no reason to exclude color plus other identifying indicia from the realm of protectible marks provided the remaining requirements for protection are met." 550 F.3d at 476; Pet. App. A at 12a (citing *Qualitex*, 514 U.S. at 163-64, and applying *Samara Bros.*, 529 U.S. at 211, requiring a showing of "secondary meaning"). Concluding that respondents' marks were protectible, the appeals court reviewed the "likelihood of confusion" "digits" *de novo* and held:

> *[G]iven the record in this case* and the digits of confusion analysis discussed above—*including the overwhelming similarity between the [petitioners'] t-shirts and the Universities' licensed products, and the [petitioners'] admitted intent to create an association with the [respondents]* and to influence consumers in calling the [Universities] to mind—that the inescapable conclusion is that many consumers would likely be confused and believe that Smack's t-shirts were sponsored or endorsed by the Universities.

Id. at 485, 33a (emphasis added). Emphasizing the case-specific nature of its holding, the court of appeals thus unanimously rejected petitioners' contentions.

The Fifth Circuit further foresaw petitioners' present claim that two of its previous cases, *Boston Professional Hockey Association, Inc. v. Dallas Cap & Emblem Manufacturing, Inc.*, 510 F.2d 1004 (5th Cir.)

("*Boston Hockey*"), *cert. denied*, 423 U.S. 868 (1975), and *Supreme Assembly, Order of Rainbow for Girls v. J.H. Ray Jewelry Co.*, 676 F.2d 1079 (5th Cir. 1982) ("*Rainbow for Girls*"), were inconsistently decided. Detailing each case's holding, the court explained that, while the fraternal organization's jewelry designs in *Rainbow for Girls* lacked secondary meaning among consumers and had no history of licensing or trademark enforcement, the professional hockey team emblems in *Boston Hockey* exclusively were associated with the hockey-team trademark owners in consumers' minds and, thus, warranted protection. *Id.* at 484-85, 31-34a.

Anticipating petitioners' "aesthetic functionality" reason for seeking *certiorari*, the Fifth Circuit discussed at length the history of the "aesthetic functionality" doctrine, noting in particular the Ninth Circuit's holding in *Au-tomotive Gold*, 457 F.3d at 1074 ("the fact that a trademark is desirable does not, and should not, render it unprotectible"), which further solidified the unanimity among courts of appeals in rejecting that doctrine. 550 F.3d at 488; Pet. App. A at 39a.

Finally, predicting petitioners' "nominative fair use" contention, the Fifth Circuit carefully detailed the proper application of that doctrine. Specifically, the court noted that "a court ordinarily should consider a nominative fair use claim in conjunction with its likelihood-of-confusion analysis. . . ." *Id.* at 489, 42a. Even assuming *arguendo* petitioners' claim that the district court considered nominative fair use *after* its likelihood-of-confusion conclusion, the Fifth Circuit observed that it has "declined to require any particular method for

the consideration in cases where the nominative use is not a significant factor in the liability determination." *Id.*

Provided the Fifth Circuit's extremely well reasoned and unanimous opinion, which, at every turn, emphasized its reliance on well established trademark principles and detailed the case-specific nature of its holdings, this Court should deny the petition.

REASONS FOR DENYING THE PETITION

Petitioners offer no compelling reason for this Court's review. The petition itself is devoted almost entirely to discussing the facts, narrow reasoning, and industry-specific (rather than broad jurisprudential) implications of this case. And two of the four questions it presents to this Court concern whether the Fifth Circuit properly followed its own precedent, *not* a proposed split in authority between courts of appeals or a federal question of substantial importance. Beyond that, the petition merely disagrees with longstanding and well-established principles of trademark law, decided by this Court and the courts of appeals.[7]

The protectibility of colors as trademarks is well-established, *Qualitex*, 514 U.S. at 166; and respondents' trademarks, consisting of color combinations, fall well within this ambit of protection. The courts below neither erred in reaching this case-specific conclusion nor in

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[7] *See* S. Ct. R. 10 ("A petition for a writ of certiorari is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law.").

applying the Fifth Circuit's own precedent regarding the likelihood-of-confusion analysis or nominative-fair-use defense. Moreover, whether a court of appeals correctly applied its own precedent is *not* an issue appropriate for *certiorari*. *See* GRESSMAN, *supra* n.6, at 253-54.

The Fifth Circuit's decision in this case also does not create a conflict among courts of appeals. Indeed, from *Boston Hockey*, *cert. denied*, 423 U.S. 868 (1975), to *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981) – the central cases petitioners cite as creating a split in authority – through more recent cases such as *Au-tomotive Gold*, 457 F.3d at 1072, *cert. denied*, 549 U.S. 1282 (2007), this Court consistently has denied *certiorari* on this issue. Moreover, the Fifth Circuit's decision in *Rainbow for Girls*, a case relied upon heavily by petitioners, demonstrates the consistency between the Fifth and Ninth Circuits; that case reached the same conclusion of non-infringement as the Ninth Circuit in *Job's Daughters*—both cases concerning fraternal organizations' attempts to stop the use of their marks on jewelry. Perhaps most fundamentally, petitioners' reliance on the Ninth Circuit's 1980 *Job's Daughters* decision is extremely misleading, as the Ninth Circuit subsequently rejected the doctrine of aesthetic functionality and favorably discussed *Boston Hockey*. *See Clicks Billiards*, 251 F.3d at 1260; and *Au-tomotive Gold*, 457 F.3d at 1072. Failing to mention either of these Ninth Circuit decisions, petitioners attempt to engineer a disagreement among circuits where none exists. For these reasons and those discussed in greater detail below, this Court should deny the petition.

A. The Court of Appeals' Rulings on the Protectibility of Respondents' Color Schemes and Likelihood of Confusion Do Not Raise Important or Unsettled Questions of Federal Law.

The decision in this case rests on firmly established trademark principles, including the ability of colors to serve as trademarks, the source-identifying function of all trademarks, and the Lanham Act's dual interests in protecting consumers and trademark owners. Contrary to petitioners' contentions, this case does not involve "issues of first impression" or unsettled federal questions of law of substantial importance. Pet. at 32-33, 37-38.

"A trademark is a word, name, symbol, device, or other designation, or a combination of such designations, that is distinctive of a person's goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others." RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (1995). The subject matter of a trademark is virtually unlimited. *Id.* cmt. g.

> A trademark can consist of almost any conceivable subject matter, from a word, personal name, trade name, symbol, device, picture, design, numeral, escutcheon, monogram, abbreviation, acronym, slogan, phrase, newspaper or magazine column title, fragrance, color (pink for insulation), a sound combination (the NBC chimes of yesteryear), label, container (the Coca-Cola bottle), package, product shape (LifeSaver candy),

> building shape, telephone number, geographical name, grade designation, or any combination of these.

1 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 1.02[1][a] (2008) (internal citations omitted). *See also Qualitex*, 514 U.S. at 161 (holding that a single color may be protected as a trademark).

All trademarks "function" to identify a product's source, sponsorship or affiliation, *Mishawaka Rubber & Woolen Manufacturing Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942); and source, sponsorship, and affiliation are co-equals under the Lanham Act. *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1122 (5th Cir. 1991), *aff'd*, 505 U.S. 763 (1992); *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 543 (5th Cir. 1998) ("The touchstone of infringement is whether the use creates a likelihood of confusion as to the 'source, affiliation, or sponsorship' [of the goods or services at issue]."); *Prof'l Golfers Ass'n of Am. v. Bankers Life & Cas. Co.*, 514 F.2d 665, 670 (5th Cir. 1975) (The Lanham Act specifically prohibits "falsely suggesting affiliation with the trademark owner in a manner likely to cause confusion as to source or sponsorship. . .").

A color scheme is a trademark when consumers associate it with a particular source, sponsorship, or affiliation. *E.g., Qualitex Co.*, 514 U.S. at 166 (green-gold press pads); *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1206 (9th Cir. 2000) (white, green, and yellow color scheme on website); *Transp., Inc. v. Mayflower Servs., Inc.*, 769 F.2d 952, 955 (4th Cir. 1985) (red and black color scheme on taxicabs); *Ideal Toy Corp.*

v. Plawner Toy Mfg. Corp., 685 F.2d 78, 80 n.3, 81 (3d Cir. 1982) (six primary colors on faces of Rubik's Cube puzzle protected against imitator). A trademark, thus, is a merchant's:

> authentic seal; by it he vouches for the goods which bear it . . . . If another uses it, he borrows the owner's reputation, whose quality no longer lies within his own control. This is an injury, even [if] the borrower does not tarnish it, or divert any sales by its use; for a reputation, like a face, is the symbol of its possessor and creator, and another can use it only as a mask.

Yale Elec. Corp., 26 F.2d at 974 (Learned Hand, J.). Trademark law "encourage[s] the production of quality products" and assures a trademark owner that "it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product." *Qualitex Co.*, 514 U.S. at 164 (internal quotation marks and citations omitted); *see also David Berg & Co. v. Gatto Int'l Trading Co.*, 884 F.2d 306, 310 (7th Cir. 1989) (when a mark is infringed, "[w]hat truly is infringed is the public's right to be secure from confusion and the corresponding right of each trademark's owner to control its own product's reputation.").

Two "amaranthine principles" animate trademark law: "One aims at protecting consumers. The other focuses on protecting [trademark owners] and their assignees." *Societe Des Produits Nestle, S.A. v. Casa Helvetia, Inc.*, 982 F.2d 633, 636 (1st Cir. 1992). Restated,

trademark law's dual purpose is to "secure to the owner of [a] mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (rejecting contention that protecting trademark rights in a design has anticompetitive effects on the market). Indeed, in addition to remedying consumer confusion, Congress had in mind in enacting the Lanham Act that "where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats." S. Rep. No. 79-1333, at 3 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274 (quoted in *Two Pesos*, 505 U.S. at 782). Thus, contrary to petitioners' contention that an owner's control of its trademark is anti-competitive, such control is essential to incentivizing investment in a mark and the maintenance of quality consumers associate with the mark. Petitioners' actions transgress the fundamental trademark protections of owners and consumers by intentionally trading on the Universities' goodwill with the knowledge that doing so deceptively entices consumers to buy petitioners' shirts rather than properly licensed ones.

Concomitantly, trademark law protects equally a direct source, such as a manufacturer, and a secondary source, such as a licensor who has granted to another permission to use his mark on a particular product. *E.g.*, RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. c (1995). When used to identify a secondary source, a trademark "signif[ies] that the goods or services are sponsored or approved by a particular business." *Id.*

"For example, the name or logo of a university on clothing can signify that the university authorizes, endorses and licenses the sale of such wearing apparel by the manufacturer." 1 McCarthy § 3:4. *See also Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535, 1547 n.28 (11th Cir. 1985) ("[M]embers of the public *do* assume that products bearing the mark of a school or sports team are sponsored or licensed by the school or team"); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204-05 (2d Cir. 1979) (upholding trademark rights in colors and design of Dallas Cowboys Cheerleaders' uniforms); *Nat'l Football League Props. Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 659 (W.D. Wash. 1982) ("Trademark law does not just protect the producers of products. The creation of confusion as to sponsorship of products is also actionable.").

In the context, for example, of a trademark infringement action brought by the University of Pittsburgh against the t-shirt manufacturer Champion, the Third Circuit explained:

> [A] consumer does not desire a 'Champion' T-shirt, he (or she) desires a 'Pitt' T-shirt. The entire impetus for the sale is the consumer's desire to identify with Pitt, or, perhaps more realistically, with Pitt's successful athletic programs. . . . [T]he crucial element is consumer desire to associate with the entity whose imprint is reproduced. This desire is based on success or notoriety which, in turn, is a result of the efforts of that entity.

Univ. of Pittsburgh v. Champion Prods., Inc., 686 F.2d 1040, 1047, 1049 (3d Cir.), *cert. denied*, 459 U.S. 1087 (1982).

As both the district court and the Fifth Circuit in this case correctly recognized, petitioners admitted that consumers buy t-shirts featuring the Universities' color schemes in combination with other identifying indicia to show their affiliation with the Universities. As a result, petitioners conceded the key issues in this case.

1. The Protectibility of Respondents' Color Schemes Is Well Established.

Contrary to petitioners' argument, the idea that color schemes are protectible as trademarks is *not* a novel proposition or an issue of "first impression." *See* Pet. at 14-15, 31-32. Rather, the protectibility of color schemes was established even before this Court's decision in *Qualitex*, 514 U.S. at 166 (holding that "color alone" can be protected as a trademark). *See, e.g., Transp., Inc.*, 769 F.2d at 955 (red and black color scheme on taxicabs held protectible); *Ideal Toy Corp.*, 685 F.2d at 81 (holding color scheme on Rubik's Cube puzzle protected as a trademark); *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 1128 (Fed. Cir. 1985) (color pink on fiberglass insulation held protectible). And this Court unequivocally has held that color schemes are protectible trademarks when they have acquired "secondary meaning" and are non-functional. *Samara Bros.*, 529 U.S. at 211-12.

A color scheme achieves "secondary meaning" when, "in the minds of the public, the primary significance of

[the mark] is to identify the source of the product rather than the product itself." *Id.* (internal quotation marks omitted). It is black-letter law that a color mark has secondary meaning when it identifies a single source in consumers' minds. *Qualitex*, 514 U.S. at 164. Petitioners thus concede secondary meaning by admitting that, for over a century, the "Universities have been using their color schemes along with other indicia to identify and distinguish themselves from others" (550 F.3d at 476; Pet. App. A at 14a), and that respondents' colors are well known among consumers "as a shorthand nonverbal visual means of identifying the universities" (*id.* (internal quotation marks omitted)).

The courts below correctly rejected petitioners' assertion that the Universities' color schemes could not constitute trademarks because respondents had entered too many license agreements and, thus, diminished the ability of the marks to signify a single source. Pet. at 15-16. As noted, trademarks identify not only direct sources, such as manufacturers, but also secondary sources, such as licensors and sponsors. *E.g.*, *Dallas Cowboys Cheerleaders, Inc.*, 604 F.2d at 204-205 ("The public's belief that the mark's owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement."); McCarthy § 3:4; Restatement § 9 cmt. c. And to be protectible, a mark is not required to signify only "origin" or "source" to consumers, but alternatively may signify sponsorship, endorsement, or affiliation. *See* 15 U.S.C. § 1125(a)(1)(A) (2006) (proscribing likelihood of confusion as to "affiliation, connection, or association, . . . or as to . . . origin, sponsorship, or approval"); *see also Team Tires Plus, Ltd. v. Tires Plus,*

Inc., 394 F.3d 831, 835 (10th Cir. 2005) ("[T]he relevant confusion under trademark law is not limited to confusion of consumers as to the source of the goods, but also includes confusion as to sponsorship or affiliation . . . ."); *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 216, 57 U.S.P.Q.2d 1097, 1107 (3d Cir. 2000) ("Marks are 'confusingly similar if ordinary consumers would likely conclude that [the two products] share a common source, affiliation, connection or sponsorship.'"); *Prof'l Golfers Ass'n*, 514 F.2d at 670 (enjoining former licensee from misleading public into believing affiliation continued after license expired).

The Universities' licensing programs thus demonstrate the strength, not weakness, of their marks. And the fact that hundreds of other apparel manufacturers, situated similarly to petitioners, have acquired licenses from respondents to use the Universities' colors and other trademarks demonstrates the *strength* of these trademarks. *Ky. Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 387 (5th Cir. 1977) (control over licensees' use of an owner's mark demonstrates strength in a mark).

In short, Petitioners' "protectibility of color schemes" and "secondary meaning" arguments do not warrant a writ of *certiorari*.

2. The Fifth Circuit Properly Followed Its Own Precedent in Conducting Its Likelihood of Confusion Analysis.

Petitioners attempt to concoct a substantial question of federal law by asserting that two previous Fifth Circuit decisions are inconsistent with one another and that, on this basis, the court misapplied the likelihood-of-confusion analysis. Pet. at 20-22.[8] Petitioners are wrong on both counts. But even if petitioners were correct, an *intra*-circuit disagreement is not a proper basis for granting a writ of *certiorari*. *E.g.*, GRESSMAN, *supra* n.6, at 253-54.

Likelihood of confusion is an extremely case-specific determination. *See, e.g., A & H Sportswear Co. v. Victoria's Secret Stores, Inc.*, 166 F.3d 197, 206-207 (3d Cir. 1999) (likelihood of confusion ultimately depends on circumstances of particular case and "inference[s] drawn from the totality of relevant facts"). To determine infringement, the courts of appeals have developed highly similar likelihood-of-confusion "factors" or

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[8] In its final pages, the petition also references two of this Court's decisions to assert that this case presents a substantial question. Pet. at 33-34. Neither decision previously has been cited in this case, and neither is relevant. *Mosely v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003) concerned trademark *dilution*, not infringement or likelihood of confusion. And *Dastar Corporation v. Twentieth Century Fox Film Corporation*, 539 U.S. 23, 35-37 (2003), concerned the boundary between copyright and trademark law and the definition of the term "origin" in the Lanham Act in relation to "author" in the Copyright Act, *not* any issue presented in this case.

"digits."[9] Both because every case involves unique mark(s) and circumstances, and because courts agree that "[n]o one factor is dispositive," a likelihood-of-confusion determination is extremely case-specific. *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 194 (5th Cir. 1998) ("a finding of a likelihood of confusion does not even require a positive finding on a majority of the[] 'digits of confusion'").

Petitioners appear to suggest that the Fifth Circuit, confused by its own holdings in *Boston Hockey* and *Rainbow for Girls*, erred in finding likelihood of confusion in this case. Pet. at 20-22. Specifically, petitioners contend that *Boston Hockey* was wrongly decided and that the present case is more like *Rainbow for Girls* (which found no infringement). *Id.* Both contentions are wrong.

First, this Court denied *certiorari* in *Boston Hockey*, 423 U.S. 868, which held that the defendant, who manufactured and sold unlicensed professional hockey team emblems bearing plaintiffs' trademarks, caused a likelihood of confusion among consumers between the

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[9] *See, e.g., Sullivan v. CBS Corp.*, 385 F.3d 772, 776-77 (7th Cir. 2004 (seven factor test); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 663-64 (5th Cir. 2000) (eight "digits"); *Jellibeans, Inc. v. Skating Clubs of Ga., Inc.*, 715 F.2d 833 (11th Cir. 1983) (seven factor test); *Frisch's Rests. v. Elby's Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir. 1982) (eight factor test); *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980) (six factor test); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979) (eight factor test); *Polaroid Corp. v. Polaroid Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.) (seven factor test), *cert denied*, 368 U.S. 820 (1961).

unlicensed emblems and products licensed by plaintiffs. 510 F.2d at 1012. In particular, that case concluded likelihood of confusion existed because defendant made and sold emblems "knowing that the public would identify them as being the [plaintiff] teams' trademarks." *Id.*[10]

In *Rainbow for Girls*, the Fifth Circuit found no likelihood of confusion when the defendant sold jewelry bearing a fraternal organization's registered trademarks. 676 F.2d at 1084. Likelihood of confusion was lacking, *inter alia*, because the facts demonstrated plaintiff's failure to control the manufacturing of jewelry bearing its trademark; it did not, for example, have a history of requiring jewelry bearing its mark to be licensed. *Id.*

Consistent with the case-specific nature of likelihood-of-confusion determinations, the holdings of these two cases are not incongruent. In fact, as the Fifth Circuit in this case noted, *Rainbow for Girls* discussed *Boston Hockey* in recognizing that "[i]t is not unreasonable to conclude, given the degree to which sports emblems are

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[10] *Boston Hockey* has been criticized for appearing to find infringement without expressly finding likelihood of confusion. *See Job's Daughters*, 633 F.2d at 918; *Gen. Mills, Inc. v. Henry Regnery Co.*, 421 F. Supp. 359, 362 (N.D. Ill. 1976); MCCARTHY § 24:10. The Fifth Circuit since repeatedly has clarified that a likelihood of confusion is required for infringement. *See, e.g.*, *Rainbow for Girls.*, 676 F.2d at 1082 n.3; *Ky. Fried Chicken Corp.*, 549 F.2d at 388. In any event, in this case both the district court and court of appeals painstakingly analyzed all of the "digits" of confusion and found that a likelihood of confusion exists as a matter of law.

used to advertise teams and endorse products, that a consumer seeing the emblem . . . on or associated with a good or service would assume some sort of sponsorship or association between the product's seller and the team." *Id.* at 1085. Restated, under the facts in *Boston Hockey*, the defendant's intent and the widely acknowledged strength of the marks were the most salient likelihood-of-confusion factors in finding infringement; in *Rainbow for Girls*, the failure of the plaintiff to police its mark or the quality of goods bearing the mark, and the weakness of plaintiff's mark, proved most significant in finding no likelihood of confusion. *See* 550 F.3d 484-85; Pet. App. A at 32-33a.

Contrary to petitioners' argument, these holdings are not inconsistent and do not suggest that the Fifth Circuit misapplied its own likelihood-of-confusion analysis. Instead, the outcomes of *Boston Hockey* and *Rainbow for Girls* merely demonstrate the extremely case-specific nature of all likelihood-of-confusion inquiries. As in *Boston Hockey*, the petition should be denied.

B. The Court of Appeals' Rulings on Aesthetic Functionality and Nominative Fair Use Are Consistent with Other Courts of Appeals' Decisions and this Court's Precedent.

Petitioners next contend that this Court should review this case on the basis of two defenses petitioners have asserted, namely "aesthetic functionality"[11] and

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[11] "Aesthetic functionality" refers to the idea that "[c]onsumers sometimes buy products bearing marks such as (Cont'd)

"nominative fair use."[12] Specifically, petitioners claim that: (1) courts of appeals disagree over the viability of the doctrine of aesthetic functionality; and (2) the district court below misapplied the doctrine of nominative fair use by considering that defense after the likelihood-of-confusion analysis, rather than during it. Neither of these contentions is correct, and neither supports granting a writ of *certiorari*.

1. The Doctrine of Aesthetic Functionality Has Been Rejected, and No Split in Authority Exists On This Issue.

Petitioners contend "the Fifth Circuit's position (in *Boston Hockey*) is at odds with the position taken by the Ninth Circuit (in *Job's Daughters*)." Pet. at 33. No such disagreement exists.

In *Boston Hockey*, the Fifth Circuit first rejected the "aesthetic functionality" doctrine. 510 F.2d at 1013 ("[T]he embroidered symbols [at issue] are sold not because of any such aesthetic characteristic but because they are the trademarks of hockey teams"), *cert. denied*, 423 U.S. 868 (1975). It subsequently has re-affirmed this

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the Nike swoosh, the Playboy bunny ears, the Mercedes tri-point star, the Ferrari stallion, and countless sports franchise logos, for the appeal of the mark itself, without regard to whether it signifies the origin or sponsorship of the product." *Au-tomotive Gold*, 457 F.3d at 1067.

[12] Nominative fair use refers to the use of a "trademark in a non-confusing way to identify the [trademark owner's] goods or services." McCarthy § 23:11.

ruling numerous times. *See Pebble Beach*, 155 F.3d. at 540 n.6 ("This circuit has rejected the doctrine of aesthetic functionality."); *Sno-Wizard Mfg., Inc. v. Eisemann Prods. Co.*, 791 F.2d 423, 426 n.3 (5th Cir. 1986) ("we thus reject . . . the aesthetic standard of functionality"); *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 428 (5th Cir. 1984) ("We particularly reject the suggestion that the doctrine of functionality insulates a second comer from liability for copying the first comer's design whenever the second comer can merely cite marketing reasons to justify the copying. . . .").

Over the years, other courts of appeals have agreed with the Fifth Circuit. *See, e.g., Eco Mfg. LLC v. Honeywell Int'l, Inc.*, 357 F.3d 649 (7th Cir. 2003) (rejecting contention that consumers preferred "look" of round thermostat); *L.D. Kichler Co.*, 192 F.3d at 1353 (Federal Circuit reversing district court's aesthetic functionality determination for the color of lighting fixtures; "Mere taste or preference cannot render a color – unless it is 'the best, or at least one, of a few superior designs' – de jure functional."); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1006 (2d Cir. 1995) (decorative motif on sweater not aesthetically functional); *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 34 (1st Cir. 1989) (adopting *Boston Hockey*; finding infringement where consumers purchased defendant's t-shirts "precisely because of th[e] reference [to

plaintiff's mark]"); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 982 n.27 (11th Cir. 1983) (rejecting defendant's contention that district court must give aesthetic functionality jury instruction); *Univ. of Pittsburgh*, 686 F.2d at 1049 (demand for goods bearing popular mark "due not to the efforts of [defendant] but rather to the efforts of the school, team, movie producer, musical group, [or entity] . . . whose current popularity makes that imprint desirable").

In *Job's Daughters*, the Ninth Circuit took issue with the plaintiff-appellee's unduly broad reading of *Boston Hockey*: "[Plaintiff] asserts that *Boston Hockey* supports its contention that even purely functional use of a trademark violates the Lanham Act. We reject the reasoning of *Boston Hockey*." 633 F.2d at 918. Understanding likelihood of confusion to be the central concern of trademark law, *Job's Daughters* reasoned that, "[i]nterpreted expansively, *Boston Hockey* holds that a trademark's owner has a complete monopoly over its use, including its functional use, in commercial merchandising." *Id.* Thus, by reading *Boston Hockey* beyond the four corners of its holding – indeed, beyond the Fifth Circuit's own interpretation of that case[13] – the Ninth Circuit, nearly thirty years ago in 1980, suggested a possible circuit split on this issue.

Since then, however, the Ninth Circuit has retreated from its position on aesthetic functionality, and the Fifth Circuit repeatedly has reaffirmed that trademark rights

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[13] *See, e.g., Rainbow for Girls.*, 676 F.2d at 1082 n.3 (reaffirming that infringement requires showing of likelihood of confusion); *Ky. Fried Chicken Corp.*, 549 F.2d at 388 (same).

do not confer unbridled monopolization – thus obviating any conceivable split among the circuits. Indeed, *Rainbow for Girls*, a case heavily relied upon by petitioners, demonstrates the harmony of the Fifth and Ninth Circuits on this issue. 676 F.2d at 1082-85 (reaching same conclusion of non-infringement as the Ninth Circuit in *Job's Daughters*, both cases concerning fraternal organizations' attempt to control use of their marks on jewelry).

Beginning in 1981, the Ninth Circuit rejected a district court's conclusion that "any feature of a product which contributes to the consumer appeal and saleability of the product is, as a matter of law, a functional element of that product." *Vuitton et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769, 773 (9th Cir. 1981) (internal quotation marks omitted). Subsequently, the court stated that, in the Ninth Circuit, "the 'aesthetic' functionality test has been limited, if not rejected, in favor of the 'utilitarian' functionality test." *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1382 n.3 (9th Cir. 1987) (internal citations omitted); *see also Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316, 1326 n.5 (9th Cir. 1998) (discussing favorably *Boston Hockey*). By 2001, the Ninth Circuit plainly stated, "[n]or has this circuit adopted the 'aesthetic functionality' theory, that is, the notion that a purely aesthetic feature can be functional," *Clicks Billiards*, 251 F.3d at 1260,[14] causing one commentator to remark: "That statement appears

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[14] *See also Cosmos Jewelry Ltd. v. Hung's Jewelry Inc.*, 61 U.S.P.Q.2d 1220, 1223-24 (D. Haw. 2001) (vacating prior order dismissing claim due to aesthetic functionality on the basis that *Clicks Billiards* rejected the aesthetic functionality theory).

to mark the final end of the Ninth Circuit's fifty year flirtation with the aesthetic functionality theory." McCarthy § 7.80 (internal quotation marks omitted).

After *Clicks Billiards*, the Ninth Circuit further mollified its past differences with other circuits when it refused to allow a maker of key chains and auto license plate holders to use the Volkswagen trademark on those items. *Au-Tomotive Gold*, 457 F.3d at 1072, *cert. denied*, 549 U.S. 1282 (2007). Coming full circle to the Fifth Circuit's holding in *Boston Hockey*, the Ninth Circuit in *Au-tomotive Gold* specifically rejected the argument that Volkswagen owners' aesthetic desire for automobile accessories that match their cars permitted defendant to use the Volkswagen trademark on such products. *Id.* The Ninth Circuit recognized that this logic (the same logic now urged by petitioners) "would be the death knell for trademark protection." *Id.* at 1064.

In this manner, whatever conflict in authority might have existed decades ago has been fully resolved by the courts of appeals. Federal courts consistently reject the doctrine of aesthetic functionality,[15] and contemporary

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[15] Petitioners' reference to *United States v. Giles*, 213 F.3d 1247, 1250-51 (10th Cir. 2000), does not evince a circuit split. The Tenth Circuit distinguished that case from *Boston Hockey* on several grounds, including: *Giles* was a criminal counterfeiting case, not a civil suit; *Boston Hockey* decided only the narrow issues of infringement and functionality; and the issue in *Giles* was the definition of the term "goods" *not* "aesthetic functionality." *Id.* Nor do the three district court decisions listed in note 4 of the petition (Pet. at 28) suggest a disagreement among courts of appeals. Those district court (Cont'd)

commentators do not view this as an issue warranting attention from this Court. *E.g.*, McCarthy § 7:81 ("'Aesthetic functionality' may be a theory in search of a rationale."). Petitioners' claimed conflicts among authorities derive not from real differences among federal courts but from petitioners' misleading omissions of the cases that demonstrate homogeneity.

Finally, even if the aesthetic functionality doctrine existed, this case would not involve it. The advantages petitioners assert for using respondents' trademarks are directly related to the Universities' reputations and goodwill, *not* to any function of the marks. 438 F. Supp. 2d at 662; Pet. App. B at 66a ("As [petitioners] admit, consumers purchase [petitioners'] shirts . . . to show support for the particular university. . . . [The Universities' color schemes and other identifying indicia] have no demonstrated value other than their significance to identify with the universities."). "Mere taste or preference cannot render a color – unless it is the best, or at least one, of a few superior designs – *de jure* functional." *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 1353 (Fed. Cir. 1999) (internal quotation

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(Cont'd)

cases are not aligned with courts of appeals' decisions. For example, although *University of Pittsburgh v. Champion Products, Inc.*, 566 F. Supp. 711 (W.D. Pa. 1983), questioned *Boston Hockey*, the Third Circuit in that case favorably quoted and discussed *Boston Hockey*, observing that, in the case at hand, a "consumer does not desire a 'Champion' T-shirt, he (or she) desires a 'Pitt' T-shirt. The entire impetus for the sale is the consumer's desire to identify with Pitt, or, perhaps more realistically, with Pitt's successful athletic programs." 686 F.2d at 1047.

marks omitted). The Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office recently emphasized this requirement that a use must be *non*-reputation related to give rise to functionality. *See Chicago Bears Football Club, Inc. v. 12th Man/ Tennessee LLC*, 2007 WL 683778, 83 U.S.P.Q.2d 1073, 1084 (T.T.A.B. Feb. 28, 2007) ("The mere fact that a trademark owner's mark is associated with a movie, television show, *university, or sports team* does not mean that it is functional and available for others to use to promote their goods when the trademark owner is actively licensing the mark for related items") (emphasis added).[16] And this Court repeatedly has iterated the same. *E.g.*, *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001) (functionality requires "significant non-reputation-related disadvantage") (internal quotation marks omitted); *Qualitex*, 514 U.S. at 169 (functionality doctrine protects against disadvantage "unrelated to recognition or reputation").

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[16] Petitioners' underlying argument is that the purpose of its t-shirts is to express the views of the wearer rather than to serve as an article of clothing. But the application of the functionality doctrine is not the appropriate means for analyzing expression. As the Eighth Circuit has explained: "The functionality doctrine serves as a buffer between patent law and trademark law by preventing a competitor from monopolizing a useful product feature in the guise of identifying itself as the source of the product." *Home Builders Ass'n of Greater St. Louis v. L & L Exhibition Mgmt., Inc.*, 226 F.3d 944, 948 (8th Cir. 2000). Free speech rights are well-recognized in trademark law through, for example, protections for comparative advertising, news reporting, parody, and noncommercial uses of marks. Petitioners' uses of respondents' marks fit none of these categories.

2. Petitioners' Nominative Fair Use Contention Does Not Support a Writ of *Certiorari*.

Petitioners' argument that the district court in this case misapplied the *sequence* of the "nominative fair use doctrine" and the "likelihood of confusion" factors is a garden variety claim of error, not a basis for granting *certiorari*. *E.g.*, GRESSMAN, *supra* n.6, at 276-77. Like petitioners' likelihood-of-confusion contention, *supra* at 20, even if petitioners were correct in their error claim (which they are not), the Fifth Circuit's review of its own precedent is not a proper issue for a writ of *certiorari*. *See* GRESSMAN, *supra* n.6, at 253-54.

Nominative fair use "is an alternative method for analyzing if there is the kind of likelihood of confusion that constitutes trademark infringement." MCCARTHY § 23:11. It allows "one [to] use another's mark truthfully to identify another's goods or services in order to describe or compare its product to the markholder's product." *Pebble Beach*, 155 F.3d at 545. *See also Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924) (Holmes, J.) ("When the mark is used *in a way that does not deceive the public* we see no such sanctity in the word as to prevent its being used to tell the truth.") (emphasis added); *New Kids on the Block v. News Am. Publ'g., Inc.*, 971 F.2d 302, 308 (9th Cir. 1992) (nominative fair use requires, *inter alia*, using only as much of the mark "as is reasonably necessary to identify the product or service" and "the user must do nothing that would,

in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder").[17]

Because the essence of nominative fair use is that "the mark is used only to describe the thing, rather than to identify its source," *id.* at 306, any rationale for its application is undermined by a clear intent to use another's mark for profit or to "free ride." In this case, petitioners'

> use of the Universities' colors and indicia is designed to create the illusion of affiliation with the Universities and essentially obtain a 'free ride' by profiting from confusion among the fans of the Universities' football teams who desire to show support for and affiliation with those teams.

550 F.3d at 483-84; Pet. App. A at 30a (citing *Boston Athletic Ass'n*, 867 F.2d at 33 ("Defendants' shirts are clearly designed to take advantage of the Boston Marathon and to benefit from the good will associated with its promotion by plaintiffs. Defendants thus obtain a 'free ride' at plaintiffs' expense.")). Because petitioners used the Universities' color schemes and indicia not merely to describe or compare petitioners' unlicensed shirts with respondents' licensed ones, but instead to suggest an association or affiliation with the Universities, the nominative fair use defense does not apply. *Id.* at 489, 42-43a.

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[17] Petitioners have asserted the nominative fair use doctrine in this case, *not* the statutory fair use provided in the Lanham Act, 15 U.S.C. § 1115 (2006).

CONCLUSION

This case neither raises substantial questions of unsettled federal law nor conflicts with any precedent of other courts of appeals or of this Court. Petitioners' attempts to exaggerate the importance of the issues raised in this case about six t-shirts are not persuasive. And petitioners' asserted conflicts among authorities arise not from actual disagreements among courts of appeals but from petitioners' omissions of cases demonstrating consistency across the federal courts.

The case-specific holdings reached by the courts below were based on a detailed analysis of the particular facts in the record, in keeping with the authority set forth by this Court and by the various courts of appeals. For all of these reasons, this Court should deny the petition for a writ of *certiorari*.

Respectfully submitted,

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APPENDIX

APPENDIX A

(1) "Bourbon Street or Bust" / "Show Us Your Beads" (Sold to OU fans):

front

back

Appendix A

(2) "Beat SoCal" (Sold to Ohio State fans):

Appendix A

(3) "Beat Oklahoma" (Sold to LSU fans):

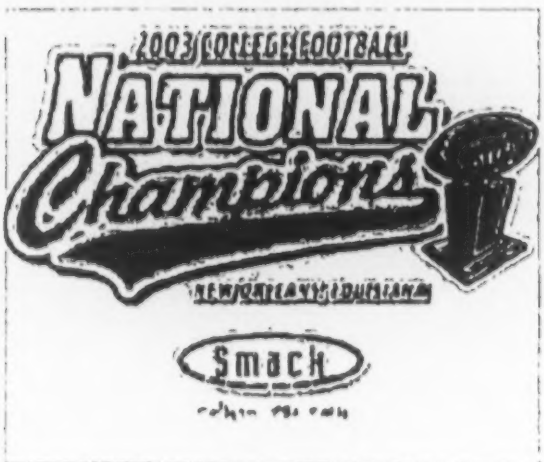
Front

Back

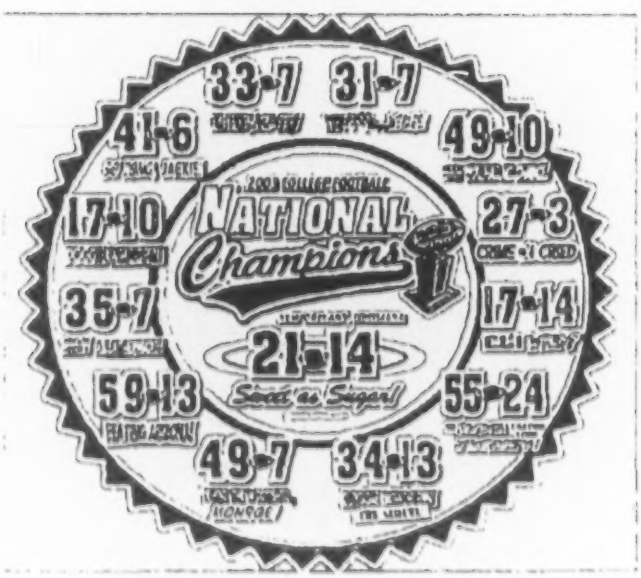
Appendix A

(4) "Sweet as Sugar"/"Sundial" (Sold to LSU fans)

Front

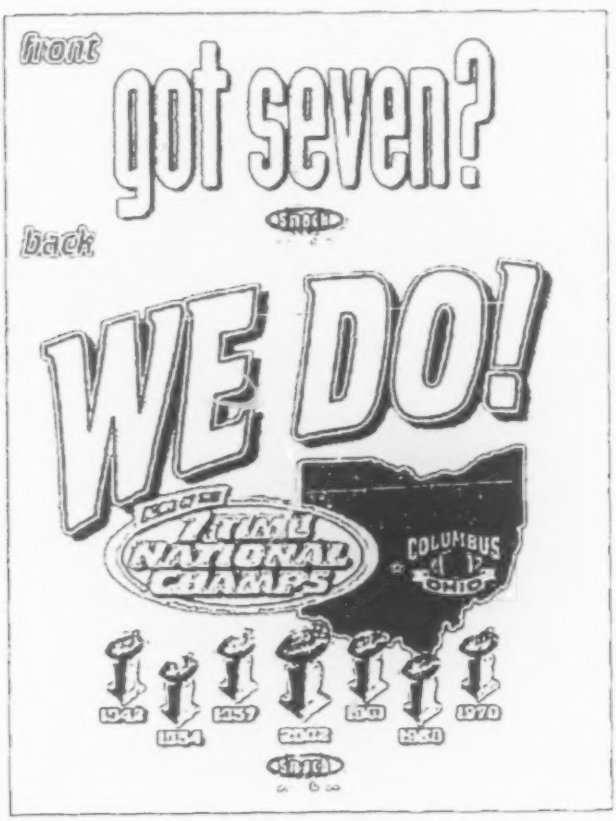


Back



Appendix A

(5) "Got Seven?" (Sold to Ohio State fans)



Appendix A

(6) "Got Eight?" (Sold to USC fans)